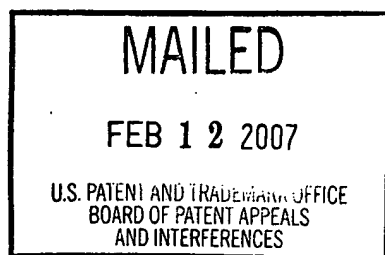


The opinion in support of the decision being entered today was *not* written for publication in a law journal and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EVA MANOLIS, CHASE GARFINKLE,
HWEI MIEN QUEK, and SU MIEN QUEK



Appeal 2006-1703
Application 09/721,484
Technology Center 3600

ON BRIEF

Before CRAWFORD, GROSS, and HORNER, *Administrative Patent Judges*.
GROSS, *Administrative Patent Judge*.

STATEMENT OF THE CASE

Manolis, Garfinkle, Quek, and Quek (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 31 through 64, which are all of the claims pending in this application.

Appellants' invention relates to a user interface for ordering image prints for multiple recipients from an on-line print service. Claim 31 is illustrative of the claimed invention, and it reads as follows:

31. A method for designating multiple recipients for an image at an on-line print service, the method comprising:

creating a plurality of envelopes and displaying each envelope on a user interface;

associating with each envelope an intended recipient to receive images placed in a respective envelope;

displaying on the user interface one or more images along with the plural envelopes;

selecting an image for distribution to multiple recipients; and

associating a selected image with two or more envelopes.

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Sharp	US 6,263,317 B1	July 17, 2001 (filed Dec. 01, 1998)
Dodd	US 6,321,211 B1	Nov. 20, 2001 (filed July 06, 1999)
Spiegel	US 6,629,079 B1	Sep. 30, 2003 (filed June 25, 1998)

Claims 31, 32, 34 through 37, 51, and 52 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Dodd.

Claims 33, 38 through 40, 53, and 54 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dodd in view of Official Notice.

Claims 41 through 44 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dodd in view of Sharp.

Claim 45 stands rejected under 35 U.S.C. § 103 as being unpatentable over Dodd in view of Spiegel.

Claims 46 through 50 and 55 through 64 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dodd in view of Sharp, Spiegel, and Official Notice.

We refer to the Examiner's Answer (mailed February 14, 2006) for the Examiner's complete reasoning and to Appellants' Brief (filed November 28, 2005) and Reply Brief (filed March 7, 2006) for Appellants' arguments.

SUMMARY OF DECISION

As a consequence of our review, we will reverse the anticipation rejection of claims 31, 32, 34 through 37, 51, and 52 and the obviousness rejections of claims 33, 38 through 50, and 53 through 64. We also remand the case to the Examiner for consideration of a possible new ground of rejection.

OPINION

The first issue is whether the Examiner properly rejected claims 31, 32, 34 through 37, 51, and 52 as being anticipated by Dodd. Appellants contend (Br. 6) that Dodd fails to show creating a plurality of envelopes and displaying each envelope on a user interface. Appellants further contend (Br. 8) that Dodd fails to show selecting an image for distribution to multiple recipients and associating a selected image with two or more envelopes. The Examiner asserts (Answer 4) that Dodd's shopping cart is an envelope and that Dodd's Figs. 1B and 1C show all of the steps of claim 31. The Examiner further suggests (Answer 9) that the list of occasions in Fig. 1C represents multiple shopping bags or envelopes and that selecting the same

gift or product for multiple recipients satisfies the step of associating an image with multiple shopping bags.

Dodd, in Fig. 1B shows the contents of an on-line shopping cart. Fig. 1B does not show a separate shopping cart for each of multiple destinations. Fig. 1C shows, for one recipient at a time, a choice of occasions, a choice of gifts, and a choice of cards. The selection of a particular occasion brings up a set of potential gifts. As nothing is placed in an occasion, nothing is "placed in a respective envelope," as recited in claim 31. Accordingly, the various occasions cannot represent envelopes.

Appellants define "envelope" (Specification, p. 10) as "a virtual storage entity for holding images that are to be printed and delivered to a single destination." A shopping cart in an on-line shopping system holds descriptions or images of objects being purchased and delivered to a single destination. However, as stated *supra*, we find no suggestion in Dodd of plural shopping carts, each being for a different destination.

"It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim." *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). *See also Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). Since Dodd fails to disclose creating plural envelopes and associating with each envelope an intended recipient of images placed in the envelope, Dodd cannot anticipate claim 31 and its dependent claims, 32, 34 through 37, 51, and 52.

The second issue is whether the Examiner properly rejected claims 33, 38 through 40, 53, and 54 under 35 U.S.C. § 103 over Dodd in view of Official Notice. Appellants contend (Br. 9) that Dodd fails to disclose the

limitations of base claim 31 regarding plural envelopes, discussed *supra*. The Examiner (Answer 6-7) relies on the same portions of Dodd to reject claims 33, 38 through 40, 53, and 54, taking Official Notice as to the limitations added in each dependent claim. As the Examiner's Official Notice does not address the limitations found lacking from Dodd (envelopes representing different destinations), the Official Notice fails to cure the deficiency noted *supra*. Thus, a prima facie case of obviousness has not been established.

The third issue is whether the Examiner properly rejected claims 41 through 44 under 35 U.S.C. § 103 over Dodd in view of Sharp. Appellants contend (Br. 11) that Dodd fails to disclose creating plural envelopes and associating an intended recipient with each envelope. Appellants further contend (Br. 11) that Sharp also fails to disclose plural envelopes, each with an associated recipient. For claims 41 through 44, the Examiner (Answer 7-8) continues to apply Dodd in the same way as for claim 31, relying on Sharp only for a teaching of an "order details button." Sharp discloses a system that allows manufacturers and distributors of brand name products to participate in e-commerce without violating distribution channels. Sharp does not discuss envelopes, and more specifically, envelopes representing different destinations. Therefore, Sharp fails to overcome the shortcomings of Dodd discussed *supra* with respect to claim 31. Accordingly, the Examiner again has failed to establish a prima facie case of obviousness.

The fourth issue is whether the Examiner properly rejected claim 45 under 35 U.S.C. § 103 as being unpatentable over Dodd in view of Spiegel. Appellants contend (Br. 12) that neither Dodd nor Spiegel discloses creating plural envelopes and associating with each envelope an intended recipient of

images. Appellants further contend (Br. 12-13) that the combination fails to show an order button for placing an order for plural envelopes from a single user interface page. The Examiner (Answer 7) again relies upon Dodd for the limitations of the base claim, 31, turning to Spiegel for a suggestion to use a single order button for plural recipients. The Examiner does not indicate what element of Spiegel constitutes a single order button for plural recipients.

We have already found Dodd lacking as to the limitations of base claim 31. Although we find that Spiegel discloses plural envelopes, each for a different recipient (discussed *infra* in the explanation for remanding the case to the Examiner), we find no suggestion in Spiegel as to how to modify Dodd to include plural envelopes. Additionally, the Examiner admits that Dodd does not disclose, nor do we find in Dodd a teaching of, a single order button as recited in claim 45. The only order buttons we find in Spiegel are the "Buy item and ship to:" button (element 103b) in Fig. 1 and the "Finalize now" button in Fig. 2. Spiegel discloses (col. 6, ll. 7-11) that button 103b, the single-action ordering button, allows a user to automatically place an order for a selected item, and have the item shipped according to the information "of the currently selected shopping cart." The "Finalize now" button finalizes an order for the selected shopping cart. See col. 6, ll. 20-39. Nowhere do we find in Spiegel a button for placing an order for multiple shopping carts from a single user interface page. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claim 45.

The last issue is whether the Examiner properly rejected claims 46 through 50 and 55 through 64 under 35 U.S.C. § 103 as being unpatentable over Dodd in view of Sharp, Spiegel, and Official Notice. Claims 46

through 50 all depend from claim 45, for which we found the combination of Dodd, Spiegel, and Official Notice lacking. As explained *supra*, Sharp does not discuss envelopes, and more specifically, envelopes representing different destinations, nor a button for placing an order for multiple envelopes, as recited in claim 45. Therefore, Sharp fails to overcome the shortcomings of Dodd, Spiegel, and Official Notice discussed *supra*.

The Examiner asserts (Answer 9) that claims 55 through 64 "have similar features of claims 31-54 treated above and are therefore rejected for the reasons stated above, with the exception that claims 55-64 have the additional features of sharing images and later making a purchase based on the received image." The Examiner asserts (Answer 9) that Dodd teaches the additional features. We have already found that combinations of Dodd, Sharp, Spiegel, and Official Notice fail to render obvious the limitations of claims 31 through 54. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 55 through 64.

In accordance with the provisions of 37 CFR § 41.50(a)(1) and the *Manual of Patent Examining Procedure* (MPEP) § 1211 (8th ed., Rev. 5, Aug. 2006), this application is remanded to the examiner for an additional response. In particular, the claims are to be reviewed in light of Spiegel in combination with the admitted prior art in the specification for a possible rejection under 35 U.S.C. § 103.

Specifically, Appellants disclose (specification, p. 2, ll. 17-27 and p. 3, ll. 4-8) that with a prior art on-line print service a user views the images, selects the ones to be printed, and enters shipping and billing information. Appellants explain (specification, p. 3, ll. 14-23) that if the user wishes to send the same prints to another person, such as a family member, the user

must repeat the entire process of selecting images and entering information, which can be time consuming.

Spiegel discloses (col. 2, ll. 35-46) that with on-line purchases, a user may use different billing or shipping information for different purchases, and re-entering information may be cumbersome. Thus, Spiegel solves the same problem as in the admitted prior art of redundant data entry in on-line shopping. Spiegel shows in Fig. 3 multiple shopping carts (301), each with a different identifier, such as "work books," Johnny's books," or "cook books." Spiegel discloses (col. 4, ll. 42-48) that if a user wants to purchase the same item for several different relatives, the user can set up a separate shopping cart for each relative, with each shopping cart having different shipment information. Appellants define "envelope" (Specification, p. 10) as "a virtual storage entity for holding images that are to be printed and delivered to a single destination." A shopping cart in an on-line shopping system, such as Spiegel's, holds descriptions or images of objects being purchased and delivered to a single destination. Therefore, Spiegel's shopping carts satisfy Appellants' definition of "envelope."

In Fig. 3 Spiegel further shows an area for describing the item being purchased. Spiegel discloses (col. 10, ll. 44-46) that an item may be added to multiple shopping carts by dragging and dropping the item onto the various carts rather than having to open each shopping cart individually. Spiegel does not disclose that the item being purchased is an image from an on-line print service. However, since the prior art on-line print service suffers the same problems as other on-line shopping systems, it would have been obvious to apply the multi-shopping cart system of Spiegel to the prior art print service. In the combination, the items to be purchased are prints of

various images, and the images themselves are the descriptions of the items to be purchased.

We decline to enter a new ground of rejection ourselves, since the application includes many dependent claims which may require additional references for a proper rejection. Instead we remand the application to the Examiner to make those determinations.

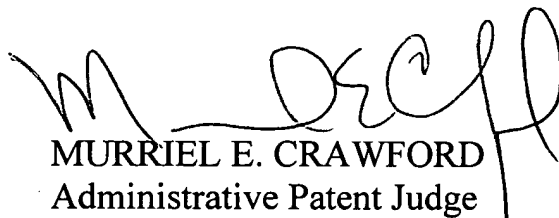
This application, by virtue of its "special" status, requires immediate action by the examiner. See MPEP § 708.01(D) (8th ed., Rev. 5, Aug. 2006). It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.


This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

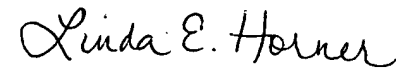
ORDER

The decision of the Examiner rejecting claims 31, 32, 34 through 37, 51, and 52 under 35 U.S.C. § 102(e) and claims 33, 38 through 50, and 53 through 64 under 35 U.S.C. § 103 is reversed. We further remand the application to the Examiner for consideration of a new ground of rejection under 35 U.S.C. § 103.

REVERSED and REMANDED


MURRIEL E. CRAWFORD
Administrative Patent Judge


ANITA PELLMAN GROSS
Administrative Patent Judge


LINDA E. HORNER
Administrative Patent Judge

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